

REMARKS

The Office Action dated February 26, 2009 has been thoroughly reviewed and Applicants submit that all issues raised therein have been addressed in this Response. Claims 1-35 are pending in the subject Application, with claims 1, 18, 19, 25, 28 and 32 being independent. Claims 1, 2, 3, 5, 18, 19 and 25 have been amended. Claims 28-35 are new. No new matter has been added. Applicants thank the Examiner for extending Applicants' counsel the courtesy of an examiner interview on March 24, 2009 to discuss the Examiner's understanding of the Herland reference and his obviousness rejections under 35 U.S.C. § 103(a).

I. 35 U.S.C. § 101

Claims 1-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (Office Action at 2). The Examiner states that claims 1-27 fail to recite any hardware elements. (Office Action at 2). The Examiner indicates that the claimed methods and systems must positively recite the thing or product to which they are tied. (Office Action at 3).

An apparatus is a "concrete thing, consisting of parts, or of certain devices and combination[s] of devices." *In re Ferguson*, 558 F.3d 1359, 1364 (Fed. Cir. 2009) (quoting *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007)). Applicants' pending claims recite methods and systems tied to computers, and in particular, computer networks, including the Internet and local area networks. Such networks are necessarily comprised of concrete elements, including servers, wires, databases, modules, computer terminals, etc. (See Herland, Fig. 1). Applicants therefore submit that the claims as currently listed satisfy 35 U.S.C. § 101.

However, to expedite this Application's prosecution, Applicants have amended independent claims 1, 18, 19 and 25 to specifically recite additional system structures that accomplish Applicants' method steps, e.g., "server", "terminal" and "display." Accordingly, Applicants respectfully request withdrawal of this rejection.

II. 35 U.S.C. § 103

Claims 1-11, 18 and 21-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Appl. Publ. No. 2003/0018747 to Herland *et al.* (“Herland”) and further in view of U.S. Patent No. 7,035,926 to Cohen *et al.* (“Cohen”). Applicants respectfully submit that claims 1-11, 18 and 21-27 are patentable over the cited references.

Amended independent claim 1 is directed to a method for enabling identification of network users having similar interests and facilitating communication between them. The method includes:

- “using the distance module, calculating a virtual distance between a web page that a user is accessing through a first terminal and web pages accessed by other users through one or more second terminals, wherein the web page that the user is accessing and each of the web pages accessed by the other users comprise any web page on the Internet”;
- “displaying for the user on a display a listing of other users determined to be within a predetermined virtual distance from the web page that the user is accessing”; and
- “enabling the user to communicate with one or more of the other users from the displayed listing.”

System claims 18 and 32 and method claims 25 and 28 recite similar, patentable features.

A. Herland

The Examiner presented Herland for the proposition that it allegedly discloses the following claimed features:

- a web page that a user is accessing and each of the other web pages comprise any web page on the Internet;
- displaying for the user a listing of other users determined to be within a predetermined virtual distance from the web page that the user has assessed, where the predetermined distance is noted by the Examiner as “the same page”; and

- enabling the user to communicate with one or more other users from the displayed listing.

The Examiner admits that Herland lacks the claimed feature of calculating a virtual distance between a web page that the user is accessing and web pages accessed by other users, and provides Cohen as teaching this feature. While Applicants do not agree with the Examiner's positions with regard to Herland, Applicants will focus their present remarks with respect to the Examiner's position of Cohen.

B. Cohen Does Not Calculate A Virtual Distance

Cohen does not disclose the use of a distance module operating on a server to calculate a virtual distance between the web page that the user is accessing and web pages accessed by other users. It is the Applicants understanding that the Examiner alleges that since Cohen discloses a selected group of mutually linked virtual places "mapped" to identify "places and links between them" (Cohen, col. 2, lines 30-33), then there is a "virtual distance" between such places where users are located, and thus, a distance is "calculated." Applicants respectfully submit that this is not "calculating" a distance. Cohen simply displays a graphic of pre-selected web pages, and links thereof, comprising a single web site or a network of pre-selected web sites within a pre-defined computer network. From this graph, a Cohen first user may *visually* identify other web pages that are being tracked. If a second user happens upon one of the tracked places, then the first user can see where the second user is on the pre-selected web sites. Cohen does not disclose "using the distance module, calculating a virtual distance" between such web sites or web pages. Any "mapping" in Cohen is not "calculating" a virtual distance between web pages. **Cohen simply tracks pre-selected web sites and shows first users where second users are on the graph.**

"[T]here is a need to provide information to users that will enable users to determine in advance which virtual places they would like to visit, *based on a knowledge of who else is visiting those places at any given time.*" (Cohen, col. 2, ll. 10-18)

Applicants' recited methods and systems are in fact the antithesis of these Cohen teachings. Applicants' specification states: "To identify and/or communicate with users having similar interests, a user must know such persons in advance or rely on a facility provided by the

application (i.e., a website). These and other *drawbacks* exist with existing systems.” (Spec. [003]) (emphasis added).

Applicants also respectfully submit that a user’s visual analysis of the graphic of Cohen is not the same as “using the distance module, calculating a virtual distance.” Again, Applicants respectfully submit that the “map” in Cohen is simply a graphic or chart, i.e., a list, of the finite, pre-selected nodes for presentation to someone who is monitoring the Cohen system. The visual “distance” between the items on the Cohen map, is not a *calculated* “virtual” distance -- there is simply no disclosure, teaching or suggestion that the layout of the finite, predetermined nodes displayed in Cohen are arranged according to virtual distances from one another.

Nor does Cohen disclose “displaying ... a listing of other users determined to be within a predetermined virtual distance.” There is no “predetermined virtual distance” in Cohen. The Examiner indeed does not point to one. Cohen identifies users at a web page independent of that web page’s location relative to other web pages. That is, Cohen does not utilize the distance between web pages as the means for identifying users at other web pages. Cohen is directed only to identifying users at a given web page at a given time by visual assessment on a display screen. To the contrary, Applicants’ method claim 1 creates a listing of those users “determined to be within a predetermined virtual distance.” Cohen is wholly silent on this functionality.

C. Herland And Cohen Are Not Combinable To Create A *Prima Facie* Obviousness Rejection Of Claims 1, 18 And 25

There is a gap in the disclosures of the cited references. Even assuming *arguendo* that Cohen *does* disclose calculating a virtual distance, neither reference discloses doing so:

- (i) between two different web pages,
- (ii) anywhere on the Internet.

Herland requires that the web pages *be the same*. Cohen is limited to a pre-defined network displayed in a map/chart, with no reference to calculated virtual distances between nodes. The Examiner has not explained why claims 1, 18 and 25 would have been obvious to a skilled artisan despite this gap. The Examiner *only* states that “[i]t would have been obvious to

one having ordinary skill in the art at the time the invention was made to include determining the virtual distance between two or more users in order to facilitate situation awareness on the Internet.” (Office Action at 4-5).

To establish a *prima facie* case of obviousness based on a combination of prior art elements, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” MPEP § 2141. The Supreme Court has indicated that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). One “must not pick and choose isolated elements from the prior art and combine them so as to yield the invention in question if such a combination would not have been obvious at the time of the invention.” *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810 (1986). Necessary to the Examiner’s analysis is considering the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Here, the Examiner has not articulated why Herland and Cohen taken together would have rendered obvious to a skilled artisan at the time of the invention:

“using the distance module, calculating a virtual distance between a web page that a user is accessing through a first terminal and web pages accessed by other users ... wherein the web page that the user is accessing and each of the web pages accessed by the other users comprise any web page on the Internet”

Lack of explanation suggests improper hindsight reasoning. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (“Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet’s invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight.”); *see also In re Kahn*, 441 F.3d 997, 986 (Fed. Cir. 2006) (“When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.”). “[I]mpermissible hindsight must

be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

Only with hindsight knowledge that a virtual distance between web pages located anywhere on the Internet may be calculated can the Examiner argue that it would have been obvious to “including determining the virtual distance between two or more users to facilitate situation awareness on the Internet.” (Office Action at 4-5). Neither Herland or Cohen suggest calculating a virtual distance between two different web pages anywhere on the Internet. Using hindsight to read these teachings into the references is inappropriate. *Graham*, 383 U.S. at 36.

D. Neither Herland Or Cohen Enable Claims 1, 18 And 25

A “conclusion of obviousness *requires* that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” MPEP § 2145 (emphasis added). Neither Herland nor Cohen teaches or suggests how to arrive at the claimed systems and methods recited in Applicants’ pending claims. And the Examiner has provided no additional reasoning or evidence as to why it would have been obvious to one of ordinary skill in the art to calculate a virtual distance between two different web sites anywhere on the Internet. Herland and Cohen each have its own limitations. There is no enabling disclosure in either reference regarding Applicants’ novel features.

E. Independent Claim 19 Is Not Obvious In View Of Herland-Wicks

Claims 19-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Herland in further view of U.S. Pat. Appl. Publ. No. 2004/0049732 to Wicks. The Examiner specifically argues that Wicks discloses filtering based on data elements of a selected attribute, value or criteria. Claim 19 recites that data is filtered “based on an affinity between data **associated with the user** and data **associated with the other users**.” (emphasis added) The data “attributes” disclosed in Wicks relate to font type, file type, etc. and are not “associated with the user” but rather a document or other electronic file. Wicks therefore does not remedy the deficiencies of Herland. Accordingly, claim 19, and claim 20 by virtue of dependency, are patentable over the cited references.

F. Claims 12-17 Are Patentable As Depending From Patentable Claim 1

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Herland-Cohen as applied to claim 1 and further in view of U.S. Pat. Appl. Publ. No. 2005/0141688 to Wengrovitz. Claims 13, 14, 16 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Herland-Cohen as applied to claim 1 above and further in view of U.S. Pat. Appl. Publ. No. 2001/0027474 to Nachman *et al.* Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Herland-Cohen-Nachman as applied to claim 13 above and further in view of U.S. Pat. Appl. Publ. No. 2001/0016825 to Pugliese III *et al.* Because claims 12-17 each depend from amended independent claim 1, they incorporate the features recited in claim 1. Therefore, claims 12-17 are patentable for at least the reasons noted above with respect to claim 1.

For at least the reasons stated above, Applicants' respectfully submit that independent claims 1, 18, 19 and 25, and claims 2-11, 12-17, 21-24 and 26-27 depending therefrom are patentable over the cited references. Accordingly, Applicants respectfully request withdrawal of these rejections.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of the pending claim and allowance of this Application. In the event the Examiner has further questions or concerns after reviewing this submission, Applicants urge the Examiner to contact Applicants' representatives at the below listed phone number to help expedite the prosecution of this Application.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account **50-0311**, Reference No. **27683-011**. The Director is further authorized to charge any required fee(s) under 37 C.F.R. §§ 1.19, 1.20, and 1.21 to the abovementioned Deposit Account.

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Respectfully submitted,



Brian P. Hopkins, Reg. No. 42,669

Brad M. Scheller, Reg. No. 61,022

Attorneys for Applicants

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, PC

Chrysler Center

666 3rd Ave., 24th Floor

New York, New York 10017

Tel.: (212) 935-3000

Fax: (212) 983-3115

Customer No. 35437